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PATENT
Attorney Docket No.: 020375-00360US

TOWNSEND and TOWNSEND and CREW LLP

By: /Kay Barclay/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Mark Thompson

Application No.: 09/971,726

Filed: October 4, 2001

For: METHODS AND SYSTEMS FOR
PROCESSING FINANCIAL
INSTRUMENTS

Customer No.: 20350

Confirmation No.: 3054

Examiner: Ali, Mohamed Hatem

Technology Center/Art Unit: 3692

**PRE-APPEAL BRIEF REQUEST FOR
REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection mailed by the Office for the above-identified application on January 10, 2008 (“the Final Office Action”). Applicant believes the rejections contain clear factual and legal deficiencies.

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 17 – 29 were withdrawn and have accordingly been canceled without prejudice or disclaimer. Claims 1 – 16 and 30 – 38 have been examined and stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 7,216,106 (“Buchanan”).

2. Rejections

First, Applicant respectfully submits that the rejections based on inherency are legally incorrect. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. Inherency, however, may not be established by probabilities or possibilities.’” (emphasis added). MPEP 2112.IV, *citing In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 – 51 (Fed. Cir. 1999).

As a first example of a legally incorrect rejection based on inherency, the Office Action rejected Claims 3 and 36 by asserting that “unique number information . . . inherently may be treated as the reference number location at the depository” (Office Action, p. 7, emphasis added). “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP 2112.IV, *citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Accordingly, the words “inherently” and “may” appear to be contradictory terms and the above assertion that includes the words “inherently may” is legally incorrect.

As a second example, the Office Action rejected Claim 16 by asserting that “other instrument . . . could be a credit-card sales slip” (Office Action, p. 7, emphasis added). However, as noted above, inherency may not be established by probabilities or possibilities (MPEP 2112.IV) and the rejection of Claim 16 is legally incorrect.

As a third example, Claims 1, 30, and 34 all require an image of a financial instrument to have been generated “as part of a **transaction at a point of sale**” (emphasis added). The Office Action rejected these claims by asserting that “deposit at a facility such as home or office [not bank] or computer-based software used at locations remote from financial institution offices for capturing deposit or remote location of businesses inherently retailing POS” (Office Action, pp. 3 and 5, emphasis added). Applicant interprets the Office Action to mean that a remote location of business inherently teaches a point of sale location. It is true that a remote location of business may or could be a point of sale location. However, a remote

location of business may also be an after-sale support center where no sale takes place. Because the missing descriptive matter is not necessarily present in the thing described in the reference, the rejections of Claims 1, 30, and 34 are legally incorrect.

Second, Claim 11 recites an initial claim limitation comprising “**provisionally crediting** an account of the presenter” and the method further comprises a claim limitation of “**releasing** the credited funds after recovery of the funds” (emphasis added). The Office Action appears to argue that the claim limitations are taught by the following: “[O]therwise known as the bank of first deposit, where the deposit may be accepted [[surely] provisional] and credited to the bank customer’s account, of course, subject to the check ‘clearing’ with the maker financial institution” (Office Action, p. 7, *citing* Buchanan, col. 1, ll. 33 – 36).

As an initial matter, it is respectfully noted that “bank of first deposit” (“BOFD”) refers to the first financial institution to which a check is negotiated, not a particular method of handling a deposit. The passage cited by the Office Action appears to teach crediting an account of the presenter (i.e., funds are *released*), and then debiting the account if the check fails to clear. This is different from “**provisionally crediting** an account of the presenter,” and *then* “**releasing** the credited funds after recovery of the funds.” Accordingly, Applicant respectfully submits that the Office Action contains at least these factual deficiencies.

Since at least some of the limitations recited in Claim 1, 3, 11, 16, 30, 34, and 36 are not taught expressly or inherently by Buchanan, these claims are patentable over Buchanan. The various dependent claims are similarly patentable by virtue of their dependence from patentable claims.

Respectfully submitted,

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